REMARKS

Rejections under 35 USC § 112:

Claims 1, 3-5 and 7-16 have been rejected under 35 USC 112 first paragraph.

Specifically, Claims 14-16 have been rejected under §112 for using an indefinite article to refer to the base claim. Applicants have amended claims 14-16 by replacing the indefinite article "A" with the definite article "The." Applicants believe the amendment obviates the rejection.

In the Action, in the last paragraph on page 3, the claims are considered enabling for a process to deliver nucleic acids *in vitro* and not *in vivo*. Applicants are puzzled by this statement since Examples 3-6 and 8 describe *in vivo* delivery and expression. In an effort to bolster their *in vivo* experiments described in the specification, Applicants have included a §1.132 Declaration showing more *in vivo* examples.

In the first paragraph on the top of page 4, the Action states that Applicants' process is enabled for only compounds listed in the specification. Although Applicants believe the number of compounds tested indicate a broader range of compounds than only those described in the Specification, they have included more compounds in their §1.132 Declaration.

Additionally, Applicants have amended their claims to include a size limitation on the compound that is attached. The amendment tracks with the data that is illustrated in the Declaration.

The §112 rejection discussed in pages 4-7 in the Action appears to center on gene therapy being one of the many uses of Applicants process. Applicants agree that their process could be used for therapeutic purposes. In fact, Applicants are currently using their labeling process for determining amounts and locations of genetic material delivered to various organs. Additionally, Applicants currently sell a commercial product that is predominately purchased by universities and corporations performing therapeutic related experiments, drug discovery experiments as well as many other uses. The process described in the Specification is not intended to be limited to therapeutic uses such as gene delivery research.

Finally, in the last paragraph on page 7, the Action indicates a lack of enablement for compound other than those particular compounds used in the Examples. Applicants believe that the compounds that were tested can be considered to fall within a group. The group is defined by a weight of or less than 60 kD. Applicants observed (see Declaration) that when the adduct attached to DNA was steptavidin-NLS-NP along with a biotin linker, the levels of expression were lower than with biotin alone, which showed less expression than no label. Applicants believe that increasing size of the adduct can eventually prevent expression.

Therefore, the claims have been amended to include the limitation "a compound, having a molecular weight of 60 kD or less." Applicants have successfully achieved expression from DNA labeled with 60 kD compounds and numerous compounds which weigh less. Size appears to be the only expression inhibitor of a compound attached to DNA.

The Examiner's objections and rejections are now believed to be overcome by this response to the Office Action. In view of Applicants' amendment and arguments, it is submitted that claims 1, 3-5 and 7-16 should be allowable.

Respectfully submitted,

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I hereby certify that this correspondence is being sent by facsimile transmission to 703.872.9306: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on this date: September 17, 2004.

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